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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/290,855	04/13/1999	ABDUL GHAFOR AKRAM	1233	1352

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EXAMINER

PHAN, MAN U

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/290,855

Applicant(s)
Akram et al.

Examiner
Man Phan

Art Unit
2665



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 21, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-9, and 11-23 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6, 7, 9, 11-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 2, 8, 21, and 23 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

DETAILED ACTION

1. This communication is in response to applicant's 04/21/2003 Amendment in the application of Akram et al. for a "Method and apparatus for simultaneous multiline phone and data services over a single access facility" filed 04/13/1999. This application is a Request for Continued Examination (RCE) under 37 C.F.R. 1.114 filed on December 9, 2003. Applicant's amendment and argument with regard to the rejection under 35 USC 103 are persuasive. Furthermore, the proposed amendment has been entered and made of record. Claim 5 has been canceled per applicant's request, and claims 1, 7, 12, 22, 23 have been amended to more particularly point out and distinctly claim the invention. Claims 1-3, 6-9 and 11-23 are pending in the application

Claim Objections

2. Claims 1, 6, 7, 22 are objected to because of the following informalities: "encoded telephonic signals" should read --encoded telephonic call signals-- (line 10 for claim 1, line 2 for claim 6, line 11 for claim 7, and line 11 for claim 22). Appropriate correction is required.

Claim 2 is objected to because of the following informalities: "the call processing unit" should read --the at least one call processing element-- (line 1). Appropriate correction is required.

Claim 8 is objected to because of the following informalities: "the call processing

unit" should read --the call processing element-- (line 1). Appropriate correction is required.

Claim 23 is objected to because of the following informalities: The claim contains the phrase "adapted to" (lines 1, 5, 7). It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 7, 12, 22 recite the limitation "the group" (line 16 for claim 1, line 16 for claim 7, line 19 for claim 12, line 16 for claim 22). There is insufficient antecedent basis for this limitation in the claims.

Claim 6 recites the limitation "the data device" (line 2). There is insufficient antecedent basis for this limitation in the claim.

Claims 7, 12, 22 recite the limitation "the plurality of telephonic devices" (line 12 for claim 7, line 15 for claim 7, line 19 for claim 12, line 12 for claim 22). There is insufficient antecedent basis for this limitation in the claims.

Claim 13 recites the limitation "the Internet" (line 2). There is insufficient

antecedent basis for this limitation in the claim.

Claims 17, 18 recite the limitation "the public switched telephone network" (line 2 for claim 17, line 4 for claim 18). There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Regnier

(US#6,345,047) in view of Doshi et al. (US#6,144,667).

With respect to claim 20, both Regnier (US#6,345,047) and Doshi et al. (US#6,144,667) disclose a novel method and system for Internet and telephonic communications systems utilizing voice over Internet Protocol (VoIP) according to the essential features of the claim. Regnier provides a computer telephony adapter for use at a subscriber site with a subscriber line, for simultaneously sending a telephone call from a PSTN compatible telephone terminal on the subscriber site, and IP packets from a first computer, over the subscriber line, the adaptor has a converter for converting signals from the telephone terminal into IP packets, and a multiplexer, for sending simultaneously the IP packets representing the telephone call and those from the computer, along the subscriber line. The adaptor is also arranged to handle calls without conversion to IP packets, when the subscriber telephone line is not used for carrying IP packets. Using one subscriber line, all phones in a household can remain operational, to make and receive calls, while one or more PCS are concurrently accessing online services, without needing a second line, or special equipment to increase the bandwidth transmissible over the line (See Figs. 6 & 14; Col. 2, lines 54 plus).

In the same field of endeavor, Doshi et al. teaches a network-based method for initiating and completing a voice telephony call via the Internet comprises the steps of receiving call completion data at a voice/data network gateway of the public switched telephone network from an Internet application web server, which may comprise an Internet service provider or other entity serving Internet users via an Internet application web server, and transmitting call completion data to telecommunications switches for

connecting an Internet user to a telephone of an application agent associated with the Internet server. The application agent may be associated with a 1-8YY toll-free number or other national or international telephone number. Call progress data is translated into data communications protocol format to be returned to the Internet server where it may be displayed to the user. Preferably, the link between the Internet application web server and the voice/data network gateway comprises a telecommunications data link, for example, an ISDN data link. Once a voice telephone call is established between a user and an application agent, other parties may be added to the call via a conference bridge. Other services and features that may not be available or implementable in a customer premises based system but are in a network-based solution comprise tone, video, facsimile, video, modem, speech recognition and other features (See Figs. 1a,b and the Abstract; Col. 4, lines 21 plus).

One skilled in the art would have recognized the need for effectively and efficiently providing multiline telephonic and data services over a single access facility using data multiplexing network in VoIP network, and would have applied Doshi's novel use of the voice/data net gateway (NAP) for encoding the incoming telephone channels into Regnier's teaching of the Home Computer telephony Adapter (HCTA) for use in VoIP. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Doshi's network-based method and apparatus for initiating and completing a telephone call via the Internet into Regnier's computer telephony adapter and method with the motivation being to provide method for supporting the multiline telephonic and data services over a single access facility in VoIP.

Allowable Subject Matter

8. Claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 1, 6-7, 12-13, 17-18 and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is an examiner's statement of reasons for the indication of allowable subject matter: The prior art of record fails to disclose or suggest one or more bypassing elements positioned between the plurality of telephonic devices and the statistical multiplexor and operative to connect the plurality of telephonic devices either to the at least one call processing element or to the communication network; a control circuitry and a customer premises equipment interface circuitry for providing at least one of the group comprising: D.C. power, indications of on-hook and off-hook conditions, ring current, ring back tones or busy tones; wherein the control circuitry communicates with the at least one call processing element and controls the customer premises equipment interface circuitry.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Strauss et al. (US#5,940,598) is cited to show the telecommunications network to internetwork universal server.

The Bansal et al. (US#6,262,063) is cited to show the system and method for provisioning an extra line on demand and for selectively connecting calls with a plurality of devices.

The Curry et al. (US#6,233,234) is cited to show the secure LAN/Internet telephony.

The Hyziak et al. (US#6,668,043) is cited to show the systems and methods for transmitting and receiving text data via a communication device.

The Foley (US#6,414,952) is cited to show the virtual gateway system and method.

The Witchalls (US#6,407,996) is cited to show the processing device network.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (703)305-1029. The examiner can normally be reached on Mon - Fri from 6:30 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (703) 308-6602. The fax phone number for the

organization where this application or proceeding is assigned is (703)305-3988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

13. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

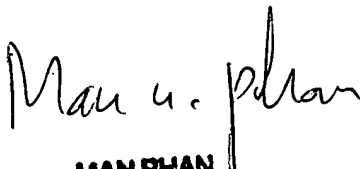
Washington, D.C. 20231

or faxed to: (703) 305-9051, (for formal communications intended for entry)

Or: (703) 305-3988 (for informal or draft communications, please label "PROPOSED" or "DRAFT"). Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

Mphan

Jan. 30, 2004.


MAN PHAN
PATENT EXAMINER